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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,028	09/11/2002	Kirk Barker	29370.20	7563
27683	7590	09/22/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PHAN, JOSEPH T	
		ART UNIT		PAPER NUMBER
		2645		✓
DATE MAILED: 09/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/065,028	BARKER ET AL.
Examiner	Art Unit	
Joseph T Phan	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 and 6-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 6-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 17, lines 10-11, recite "...without involving a centrally located exchange device." Applicant's specification and drawings(10 of Fig.1, 206b of Fig.2, and 402 of Fig.4) discloses PBX's(page 3 of applicant's specification), hubs(page 4), and switches(page 6) that are all centrally located exchange devices, therefore it is unclear how applicant's invention operates as a centrally located device that exchange data is needed for communication. Appropriate clarification or correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4 and 6-23 rejected under 35 U.S.C. 102(b) as being anticipated by Qua et al., Patent #6,222,909.**

Regarding claim 1, Qua teaches a method for on-demand recording of a voice

session by a telephone recording device in a telecommunication network, the method comprising:

establishing a voice session between the telephone recording device and at least one communication device (col.2 lines 49-63);

automatically temporarily storing voice data representing the voice session in a memory buffer device in a storage server (*col.4 lines 4-25 and col.6 lines 6-11; once user initiates recording, the audio note taken mechanism automatically determines and temporarily stores the voice session in a server memory*);

instructing the telephone recording device to store the voice data, wherein the instruction can occur at any time during the voice session so long as the voice session has not been terminated, and wherein the instruction to store the voice data is initiated by a user of the telephone recording device during the voice session (col.4 line 57-col.5 line 15).

processing the voice data by the telephone recording device to be transmitted to and saved at a storage server, wherein the saved voice data is available for on-demand replay (col.3 line 45-col.4 line 3).

Regarding claim 2, Qua teaches the method of claim 1 further comprising duplicating the voice data at the telephone recording device and storing in a memory buffer device contained therein (col.4 lines 40-56)

Regarding claim 3, Qua teaches the method of claim 1 further comprising: persistently storing the temporarily stored voice data in the storage server only after the instruction for recording is received (col.4 lines 40-56).

Regarding claim 4, Qua teaches the method of claim 1 wherein the processing further comprises digitizing the voice data (col.2 lines 40-48 and col.7 lines 20-30),

Regarding claim 6, Qua teaches the method of claim 1 wherein the voice session is carried out through a local switch device which serves both the telephone recording device and the communication device without involving a centrally located exchange device(col.3 line 22-col.4 line 3).

Regarding claim 7, Qua teaches the method of claim 1 wherein the voice session is carried out through two local switch devices directly connected therewith, a first local switch device servicing the telephone recording device and a second local switch device servicing the communication device(col.3 line 22-col.4 line 3).

Regarding claim 8, Qua teaches the method of claim 7 wherein the first local switch device is connected to the storage server(col.3 line 22-col.4 line 3).

Regarding claim 9, Qua teaches the method of claim 7 wherein the first local switch device is connected to a call manager server for managing the voice session (col.3 line 22-col.4 line 3).

**Regarding claim 10, Qua** teaches a system for on-demand recording of voice data, comprising:

at least one local switch device for establishing a voice session between a communication device and a telephone recording device(125 or 135 fig.1 and col.2 lines 49-63);

a memory buffer for temporarily storing voice data representing the voice session(110-120 or 130 fig.1, col.3 lines 40-67 and col.4 lines 4-25);

a storage server connected to the local switch device for saving the voice data sent by the telephone recording device(125 or 135 fig.1, col.3 lines 40-67, and col.5 line 46-col.6 line 11),

a save initiator for dynamically initiating the voice data recording during the voice session(fig.4-6), wherein the recording can be started by a user at any time during the voice session(col.4 lines 40-56), and wherein the recording saves the entire voice session by copying the voice data from the memory buffer to the storage server(*fig. 1,col.3 lines 40-67, col.4 line 57-col.5 line 7, and col.5 line 43-col.6 line 11*); *audio note taken mechanism saves the entire voice session from the memory buffer to the storage server*);

wherein the telephone recording device processes and transmits the voice data to the storage server through the local switch device (*col.3 line 40-col.4 line 3, col.4 line 57-col.5 line 7, and col.5 line 43-col.6 line 11*).

Regarding claim 11, Qua teaches the system of claim 10 wherein the telephone recording device processes and transmits the voice data to the storage server through the local switch device without involving a private branch exchange (PBX) (Fig.1)

Regarding claim 12, Qua teaches the system of claim 10 wherein the local switch device is a hub device (Fig.1)

Regarding claim 13, Qua teaches the system of claim 10 wherein the local switch device is a local switch (Fig.1).

Regarding claim 14, Qua teaches the system of claim 10 wherein the telephone recording device includes a processor for digitizing the voice data (col.2 lines 40-48 and col.7 lines 20-30),

Regarding claim 15, Qua teaches the system of claim 10 wherein the save initiator is on the telephone recording device (fig.4-Fig.6 and col.3 line 22-col.4 line 3).

**Regarding claim 16, Qua** teaches a telephone recording device used in an on-demand voice data recording system, comprising:  
means for establishing a voice session with a communication device through communications with at least one local switch device (Fig.1)  
a save initiator on the telephone recording device for dynamically initiating the voice data recording at any time during the voice session, wherein the voice data represents the voice session from the beginning of the voice session (Fig.4-Fig.6, col.4 line 57- col.5 line 7, and col.7 lines 1-19);  
processing means for digitizing the voice data into a digital form and storage buffering means for saving the digitized voice data and (col.2 lines 40-48 and col.7 lines 20-30), transmission module for sending the digitized voice data from the storage buffering means to a storage server connected to the local switch device (col.3 line 40-col.4 line 56).

**Regarding claim 17, Qua** teaches a system for on-demand recording of voice data, the system comprising:  
a telephone recording device connected to a first local switch device, at least one communication device connected to a second local switch device for establishing a

voice session with the telephone recording device through a communication link between the first and second local switch device(Fig.1 and col.3 line 22-col.4 line 3); a save initiator for dynamically initiating the voice data recording during the voice session in real time in response to user input, wherein the voice data represents the voice session from the beginning of the voice session (col.3 line 22-col.4 line 3 and col.7 lines 1-19), and a storage server connected to the first local switch device for saving the voice data sent by the telephone recording device(Fig.1), wherein the telephone recording device processes and transmits the voice data to the storage server through the first local switch device without involving a centrally located exchange device(col.3 line 40-col.4 line 56).

**Regarding claim 18, Qua** teaches a system for peer-to-peer on-demand recording of voice data, the system comprising:  
a telephone recording device and at least one communication device connected to a local switch device(Fig.1 and col.3 line 22-col.4 line 3), the telephone recording device having: a save initiator for dynamically initiating the voice data recording after a voice session is established between the telephone recording device and the communication device(fig.4-6), wherein the voice data is a representation of the voice session, and wherein the save initiator is configured to initiate the recording in response to user input received at any time until the voice session is terminated(Fig.4-Fig.6, col.3 line 22-col.4 line 3 and col.7 lines 1-19);

processing means for packetizing the voice data and memory buffer for temporarily storing the voice data(col.3 lines 59-67); and storage server connected to the local switch device for storing the temporarily saved voice data sent by the telephone recording device (col.3 line 40-col.4 line 56).

Regarding claim 19, Qua teaches the system of claim 18 further comprising a replay means on the telephone recording system for playing back the stored voice data(col.6 lines 11-58).

Regarding claim 20, Qua teaches the system of claim 18 wherein the memory buffer is on the telephone recording device (col.3 line 40-col.4 line 56 and col.6 lines 11-58).

Regarding claim 21, Qua teaches the system of claim 18 wherein the memory buffer is on the storage server (col.3 line 40-col.4 line 56 and col.6 lines 11-58).

**Regarding claim 22, Qua** teaches a method for storing a peer-to-peer telephone conversation session between a coordinating user using a telephone recording device and at least one regular user using at least one communication device which does not have a recording feature(Fig.4-6 and col.3 lines 22-67), the method comprising: establishing the peer-to-peer telephone conversation session between the telephone recording device and the communication device through a local switch device(135 Fig.1); temporarily saving voice data of the session in a memory buffer of the telephone recording device(*110-120 fig.1, col.4 lines 4-25*); and instructing, by the user, during the session and before the session ends, the telephone recording device to store the temporarily saved voice data in a storage server connected to the local switch

device(*col.4 lines 59-67 or col.5 line 43-col.6 line 11; pc or voicemail server is connected to switch device*).

Regarding claim 23, Qua teaches the method of claim 20 further comprising replaying the stored voice data(*col.6 lines 11-58*).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-4 and 6-21 have been considered but are moot in view of the new ground(s) of rejection. Claims 22-23 are not persuasive. The claims as recited still does not read away from the prior art of record, specifically the added limitation of "automatically temporarily storing voice data representing the voice session in a memory buffer" does not further limit the claim as explained and detailed in rejected claim 1 above.

Regarding claims 10-18 and 22 Applicant argues that the prior art of record, Qua fails to teach *temporarily storing voice data representing the voice session...wherein the recording saves the entire voice session by copying voice data from the memory buffer to the storage server*), Examiner respectfully disagrees as Qua teaches saving the entire voice session into the memory buffer(detachable storage unit of terminal 110 fig.1 col.4 lines 19-25) then copying(saving) it to an voicemail server or pc (*col.4 lines 59-67 or col.5 lines 43-67*). Additionally, the save initiator in Qua is the terminal itself that the user uses to record the conversation with audio notes (fig.4-6). Therefore the prior art of record still reads on the claims as recited.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 17, 2004

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